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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/782,385

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Satoshi Mizutani

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DARBY & DARBY P.C.

P.O. BOX 770

Church Street Station

New York, NY 10008-0770

EXAMINER

KIDWELL, MICHELE M

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/782,385	Applicant(s) MIZUTANI ET AL.	
	Examiner Michele Kidwell	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,10,11,23,26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,10,11,23,26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/9/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 28, 2008 has been entered.

Claim Objections

Claim 1 is objected to because of the following informalities: the claim recites that the first sheet forms a surface side sheet "configured contacting" a body in line 3. The language does not make sense. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 23, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 888 764 A1 in view of Osborn, III et al. (US 5,885,265).

With reference to claim 1, EP 0 888 764 A1 (hereinafter '764) discloses an interlabial pad comprising an absorbent body (24) for absorbing liquid;

a permeable first sheet (22) forming a surface side sheet which covers a first face side of the absorbent body (figure 2);

a second sheet (23) independent from the first sheet and contacting a second face side opposite to the first face side of the absorbent body and forming a back face side sheet configured to be positioned away from the body (figure 2), the second sheet including a plurality of sheet pieces (col. 10, lines 14 – 18); at least one seam part of the second sheet formed by overlapping the plurality of sheet pieces over one another (figure 5A and figure 5A) wherein the second sheet contacts the second face side of the absorbent body along the region of the second sheet having the longitudinal seam part (figures 5A and 5B), and

a junction joining the surface side sheet and the back face side sheet at a peripheral edge of the absorbent body, the absorbent body being enclosed thereby between the surface side sheet and the back face side sheet (figures 5A – 5C);

a mini-sheet piece (58) being adhered to the back face sheet of the article and forming a pocket between the mini-sheet piece and the back face side sheet, wherein a finger of a user may be inserted into the pocket (figure 5B) wherein an outer surface of the seam part is embossed as set forth in col. 10, lines 24 – 26.

The difference between '764 and claim 1 is the provision that the article is formed of either a water disintegrable material or a biodegradable material and that the mini-sheet piece is adhered to the junction.

Osborn, III et al. (hereinafter "Osborn") teaches a water dispersible interlabial pad as set forth in the abstract.

It would have been obvious to one of ordinary skill in the art to provide the article of '764 with the dispersible material as taught by Osborn because the use of such provides the added convenience of being able to flush the soiled article down the toilet as taught by Osborn in col. 2, lines 24 - 37.

Regarding the adherence of the mini-sheet to the junction, the examiner contends that the rationale for doing so is within the level of ordinary skill in the art as the reference discloses that the sheet may be attached at any portion of the backsheet as set forth in col. 17, lines 20 – 35.

With reference to claims 6 and 23, see figure 3 of '764.

Regarding claim 26, '764 in view of Osborn does not teach the specific ranges of values for the basis weight of the adhesive. Generally, optimization of ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

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One of ordinary skill in the art would have recognized that increasing the basis weight of adhesive would provide for increased adhesion while slowing dispersion in water.

As to claim 28, see figures 3 and 5B of '764.

Claims 10 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 888 764 A1 in view of Osborn, III et al. (US 5,885,265) and further in view Osborn, III (WO 99/26573 A1; hereinafter "573").

'764 in view of Osborn does not disclose expressly the packaging sheet.

'573 teaches a packaging body (50) for a sanitary pad (20), comprising:

a packaging sheet (68); and

a sanitary pad (20) covered by the packaging sheet (68);

wherein the packaging sheet (68) is provided with a continuous or discontinuous parting zone that is parted by actions of water, along which the packaging sheet (68) is separated into a plurality of small sheet piece when water after the packaging sheet is discarded in the toilet (page 19, line 20-page 21, line 23)(see fig. 5).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to use the packaging of Osborn to package the pad of '764 in view of Osborn in order to provide packaging that is known in the art to be suitable for that purpose.

Regarding the functional limitations, e.g., how the back side sheet disperses after placement in a toilet, apparatus claims must be structurally distinguishable over the prior art. MPEP § 2114. '573 discloses packaging that can optionally be constructed of

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a dissolvable material. Even if the packaging is not torn open, it will eventually dissolve, even if this not an intended use of the disclosure.

Regarding claim 11, '573 teaches that the packaging sheet is a liquid impermeable sheet (e.g., thermoplastic film) with an impermeable property against liquid (page 19, lines 20-31).

Response to Arguments

Applicant's arguments with respect to claims 1, 6, 10 – 11, 23, 26 and 28 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele Kidwell/
Primary Examiner, Art Unit 3761